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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,096	04/12/2000	HANS TANDLER	GK-ZEI-3078	5855

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/463,096	TANDLER ET AL.
	Examiner Lee Fineman	Art Unit 2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 24 February 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 13-15 and 17-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 13-15 and 17-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 24 February 2003 is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

This Office Action is in response to an amendment filed 24 February 2003 in paper number 20 in which claims 13-15 and 19-23 were amended. Claims 13-15 and 17-23 are pending.

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 24 February 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 13-15 and 17-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to specifically identify that no monitoring system (claim 13, line 7) is included. The applicant is now relying on this limitation as criticalness to the patentability. As such, the examiner contends, absent specific support in the specification, that this subject matter

was not considered within the metes and bounds of the invention as originally filed. The dependent claims inherit the deficiencies of the claim 13 from which they depend.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al., U.S. Patent No. 5,742,735.

Regarding claim 13, Nagashima et al. discloses an arrangement for directly controlling the movement of a zoom system comprising driving means (9 and 10) for at least one moving lens system (2 or 3) wherein the driving means are being controlled by a control unit (6) which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving means in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve and without a monitoring system for the driving means (column 3, lines 13-24).

Nagashima et al. discloses driving means to linearly move the lens groups. This arrangement appears to be linear drive motors. However in as much as linear drive motors are not explicitly disclosed, use of such well known drive means would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide precise linear movement of the lens groups. Stepper motors are a common example of this type of drive means, which are known to provide highly accurate linear movement in a stepwise fashion.

The recitation "in a stereo microscope" has not been given significant patentable weight because the recitation occurs in the preamble where it merely recites the intended use of a structure and fails to structurally limit the body of the claim.

Regarding claim 14, Nagashima et al. further discloses at least one moving lens system (2 or 3) controlled independently from one another (column 2, lines 42-47; Nagashima). Nagashima et al. discloses the claimed invention except for the moving lens systems comprising two lens members. Official Notice is taken that zoom lens groups commonly have more than one lens member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add another lens member to the moving lens systems (groups) of Nagashima et al. to adjust/correct for aberrations and other optical conditions.

6. Claims 15, 17, 20-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant application which is admitted prior art (Admission) in view of Nagashima et al.

Regarding claim 17, Admission discloses a stereomicroscope with a zoom system (fig. 1) comprising a drive motor (M) driving at least one moving lens system (L1 or L2). Admission lacks the driving motors being controlled by a control unit which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner

without necessitating use of mechanical generation of the mathematical controlling curve and without an additional monitoring system. Nagashima et al. teaches a zoom system with a driving means (9 and 10) being controlled by a control unit (6) which reads calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system (2 or 3) by controlling the driving means in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve and without a monitoring system for the driving means (column 3, lines 13-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the drive unit of Admission with the drive unit of Nagashima et al. to be able to maintain an in-focus image during zooming (column 2, lines 6-9; Nagashima).

Nagashima et al. discloses driving means to linearly move the lens groups. This arrangement appears to be linear drive motors. However in as much as linear drive motors are not explicitly disclosed, use of such well known drive means would have been obvious to one of ordinary skill in the art at the time the invention was made to provide precise linear movement of the lens groups. Stepper motors are a common example of this type of drive means, which are known to provide highly accurate linear movement in a stepwise fashion.

Regarding claim 15 and 20, Admission in view of Nagashima et al. discloses lens members that comprise at least one moving lens system (L1 or L2) and are provided as lens pairs in a Greenough type stereomicroscope or telescope type stereomicroscope (Admission, fig 1). Each lens pair is a plurality of moving lens members that are comprised of at least one moving lens system (L1 or L2) and are controlled jointly.

Regarding claims 18 and 19, Admission in view of Nagashima et al. discloses the claimed invention but is silent to the linear drives being arranged in the stereomicroscope housing and between the lens pairs. Official Notice is taken that having linear drives being arranged in a device housing is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear drives of Admission in view of Nagashima et al. be arranged in the stereomicroscope housing in order to protect against foreign particles, etc. which would interfere with the operation of the motors. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the driving motors of Admission in view of Nagashima et al. to be between the lens pairs, since it has been held that a mere rearrangement of an element without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the driving motors to be between the lens pairs again for the purpose of making the overall device more compact. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding claim 21, Admission in view of Nagashima et al. discloses two lens members that comprise at least one moving lens system (L1 or L2) and are controlled independently from one another (column 2, lines 42-47; Nagashima).

Regarding claim 23, Admission in view of Nagashima et al. discloses a control unit (6; Nagashima) used for motorized zoom adjustment and for motorized focusing (column 3, lines 13-18).

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7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Nagashima et al. as applied to claim 13 above, and further in view of Pensel et al, U.S. Patent No. 5,867,308.

Admission in view of Nagashima et al. discloses the claimed invention except for a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system. Pensel et al. teaches a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system (12, fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear magnification of Admission in view of Nagashima et al. that is adjusted be determined and displayed as Pensel et al. suggests in order to arrive at a desired magnification with ease.

#### *Response to Arguments*

8. Applicant's arguments filed 24 February 2003 have been fully considered but they are not persuasive.

The applicant directed the examiner to page 3, lines 15-19 for support of the limitation "without a monitoring system for the driving motors" in claim 13. A review of this section reveals no disclosure to a system without monitoring. Again, the absence of a feature in the disclosure as originally filed does not provide support for a negative limitation in the claims directed to this feature.

9. Applicant's arguments with respect to the Thomas reference have been considered but are moot in view of the new ground(s) of rejection.

10. It is noted by the Examiner that the claim objections made in the previous Office Action have been withdrawn due to amendment by the Applicant.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



LAF

May 1, 2003



MARK A. ROBINSON  
PRIMARY EXAMINER